

REMARKS

Claims 1, 2, 6 and 8-12 are pending in this application. By this Amendment, claims 10-12 are added. Support for the amendments may be found, for example, in the specification at page 28, lines 20-23. No new matter is added.

In view of the foregoing amendments and following remarks, reconsideration and allowance of the claims are respectfully requested.

I. Rejection Under 35 U.S.C. §112

Claims 6 and 8 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants respectfully traverse the rejection.

Claim 6 recites, *inter alia*:

The cover tape for tape-packaging electronic components according to claim 2, wherein ...
a peeling strength upon separation of the soft material layer from the thermal adhesive layer is in a range of from 0.1 N/mm width to 1.3 N/mm width, and
a difference between a maximum value of the peeling strength upon separation of the soft material layer from the thermal adhesive layer and a minimum value thereof is equal to or less than 0.3 N/mm width.

(Emphasis added). Claim 8 recites similar features.

An evaluation of whether a claim particularly points out and distinctly defines the metes and bounds of the claimed subject matter as required by 35 U.S.C. §112, second paragraph, "is an objective one because it is not dependent on the views of Applicant or any particular individual, but is evaluated in the context of whether the claim is definite -- i.e., whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art." *See* MPEP §2171.

Furthermore, MPEP §2173.03 provides that:

Definiteness of claim language must be analyzed, not in a vacuum, but in light of:
(A) The content of the particular application disclosure;

(B) The teachings of the prior art; and
(C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent.

Applicants respectfully submit that the teachings of the specification and art are sufficient for one of ordinary skill in the art to select procedures and conditions to carry out the determination of the minimum and maximum peeling strengths recited in claims 6 and 8.

The Office Action asserts (1) that "[i]t is unclear what test procedures and under what conditions the peeling strength is determined," and (2) that "[i]t is unclear how one would go about determining minimum and maximum peeling strengths." *See* Office Action, page 3.

Applicants respectfully disagree.

With respect to claims 6 and 8, Applicants respectfully submit that guidance and exemplary conditions for determining the peeling strength are expressly provided in the specification. Specifically, the specification recites that peeling strength from a cover tape "was measured at a peeling velocity of 300 mm/minute and a peeling angle of 180°, by means of PEEL-BACK-TESTER (Vanguard Systems, Inc., trade name) under a condition wherein the temperature was 23° C and the relative humidity was 40%." *See* Specification, page 31, lines 21-25. Further, the manner in which peeling is performed can be determined by heat-sealing conditions and whether or not the carrier tape and the cover tape are fusion-bonded to each other. *See* Specification, page 31, lines 30-33. Thus, in view of the above, it is respectfully submitted that the specification not only provides guidance regarding exemplary conditions for one of ordinary skill in the art to determine peeling strength, but it also provides detailed parameters and procedural steps that may be carried out to determine

peeling strength. Accordingly, reading the claims in light of the guidance provided in the specification, one of ordinary skill in the art would have been readily capable of determining peeling strength implementing the above-mentioned procedures under conditions typically used by those skilled in the art to measure the peeling strength.

Applicants also respectfully submit that one skilled in the art would possess adequate understanding regarding various conventional testing procedures and conditions for determining the maximum and minimum peeling strength of cover tapes such that the scope of claims 6 and 8 would have been clear to one of ordinary skill in the art at the time of invention. For example, further guidance regarding conventional testing procedures and conditions for determining the peeling strengths of cover tapes employing a substrate/soft material layer/thermal adhesive layer construction, which utilize a peeling force between the soft material layer and the thermal adhesive layer (and a cover tape in which a thermal adhesive layer is suitably heat-sealed to a carrier tape by means of a cushion characteristic of a soft material layer to provide a predetermined peeling force) may be found in many of the Patent Documents (see Patent Documents 1-25) set forth at pages 3 and 4 of the specification.

Thus, in view of the above, it would have been sufficiently clear to one of ordinary skill in the art how minimum and maximum peeling strengths are determined based upon visible physical effects to the carrier tape and the contents of the tape package in relation to the amount of peeling strength/force that is applied.

For at least the reasons presented above, Applicants respectfully submit that claims 6 and 8 meet the requirements of 35 U.S.C. §112, second paragraph. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

II. Rejection Under 35 U.S.C. §103

The Office Action rejects claims 1, 2, 6, 8, and 9 under 35 U.S.C. §103(a) over JP 08-258888 to Miyamoto ("Miyamoto") in view of U.S. Patent No. 6,586,061 to Sasaki et al. ("Sasaki"). Applicants respectfully traverse the rejection.

Claim 1 recites, *inter alia*,

A cover tape for tape-packaging electronic components,
for heat-sealing a carrier tape storing therein electronic
components, comprising: ...
a soft material layer ...
the soft material layer is formed of metallocene linear
low-density polyethylene; and
the metallocene linear low-density polyethylene has a specific
gravity in a range of from 0.888 to 0.907,
wherein a softening temperature of the metallocene
linear low-density polyethylene measured by a TMA method
defined in JIS K7196 is in a range of from 75°C to 97°C.

(Emphasis added). Applicants respectfully submit that Miyamoto and Sasaki, individually or in combination, would not have rendered obvious at least the above features of claim 1.

The Office Action asserts that Miyamoto discloses a cover tape for surface mounting embossed semiconductors that comprises a metallocene catalyzed ethylene copolymer intermediate layer. *See* Office Action, page 2. The Office Action acknowledges that Miyamoto does not disclose a metallocene linear low-density polyethylene having a particular softening temperature as recited in claim 1. *Id.* To address this discrepancy, the Office Action applies Sasaki as allegedly disclosing a metallocene catalyzed ethylene intermediate layer having a softening temperature in the range of 65° C to 125° C. *See* Office Action, pages 2 and 3. In support of its allegation, the Office Action asserts that it would have been obvious to have optimized the softening point of the intermediate layer of Sasaki to achieve the softening temperature recited in claim 1 in order to improve flexibility, transparency, pin hole resistance and film strength. *See* Office Action, page 3.

Applicants respectfully submit that one of ordinary skill in the art would not have modified Miyamoto in view of the teachings of Sasaki at least because the Office Action's proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. In fact, the teachings of Miyamoto would have led one of ordinary skill in the art away from the use of metallocene linear low-density polyethylene in cover tapes due to the undesirable effects described in the reference.

Miyamoto discloses a cover tape with an ethylene- α -olefin copolymer polymerized with a metallocene catalyst (*see* Miyamoto, Abstract) and recognizes the need for transparent cover tapes. *See* Miyamoto, paragraph [0004]. In fact, Miyamoto discloses that some of the advantages of its own cover tape extend from possessing enhanced mechanical strength without sacrificing transparency. *Id.* However, Miyamoto teaches that it was unable to maintain adequate transparent properties in its cover tape when metallocene linear low-density polyethylene was incorporated into the tape. *See* Miyamoto, paragraph [0008]. Not only did transparent properties of its cover tape worsen, but the low-temperature heat-sealing nature of the cover tape also diminished. *Id.* Specifically, Miyamoto discloses that although it is possible for giving tear resistance and tension-proof shock nature to LDPE by using LLDPE, low-temperature sealing nature and transparency will worsen. *See* Miyamoto, paragraph [0008]. Thus, Miyamoto clearly teaches away from the incorporation of metallocene linear low-density polyethylene into the cover tapes disclosed therein.

In modifying the teachings of Miyamoto in view of Sasaki, the Office Action makes no attempt to reconcile Miyamoto's clear teaching away from incorporating the metallocene linear low-density polyethylene into the cover tapes disclosed therein.

In view of the teachings of Miyamoto (such as at paragraph [0008]), modifying Miyamoto in the manner asserted by the Office Action (i.e., including metallocene linear low-density polyethylene into the cover tape of Miyamoto), would have rendered the cover tape of

unsatisfactory for its intended purpose. It is well established that "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); see also MPEP §2143.01(V). Accordingly, the rejection is improper, at least because the Office Action has failed to establish a proper *prima facie* case of obviousness.

Thus, for at least the reasons presented above, one of ordinary skill would have had no reason or rationale to modify Miyamoto in view of Sasaki because Miyamoto teaches away from the presence of metallocene linear low-density polyethylene in its cover tapes and, thus, the Office Action's proposed modification of Miyamoto would render Miyamoto unsatisfactory for its intended purpose. Thus, the Office Action combines the applied references solely based on Applicants claims as a roadmap, which is clearly improper.

For at least the reasons presented above, Miyamoto and Sasaki, individually or in combination, would not have rendered obvious claim 1. The remaining claims variously depend from claim 1 and likewise would not have been rendered obvious. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

III. New Claims

By this Amendment, new claims 10-12 are presented. New claims 10-12 depend from claim 1 and, thus, are distinguishable over the applied references for at least the reasons discussed above with respect to claim 1.

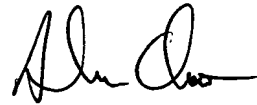
Accordingly, prompt allowance of new claims 10-12 is respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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